REMARKS

Claims 1-15 are pending in the application. Claim 1 is currently amended, and claims 3, 8, 10, and 14-15 are withdrawn as discussed below.

Applicants are being required to elect one of the following groups pursuant to 35 U.S.C. § 121:

I. Claims 2, 7, 9, 11 drawn to W is phenyl compounds, classified in class 546, subclass 216. Generic claims 1, 4-6, 12-13 will be prosecuted with the elected compounds to the extent of the elected compounds.

II. Claims 3, 8, 10 drawn to W is pyridyl compounds, classified in class 546, subclass 193. Generic claims 1, 4-6, 12-13 will be prosecuted with the elected compounds to the extent of the elected compounds.

III. Claims 1, 4-6, 12-13 drawn to remaining compounds, classified in various classes and various subclasses, depending on species election.

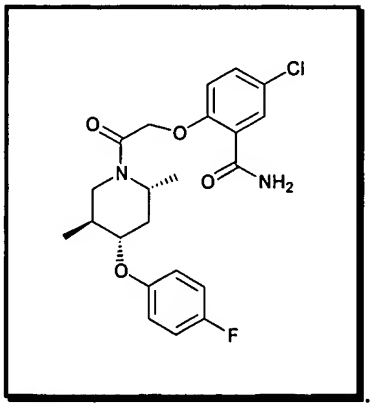
IV. Claims 14-15 drawn to method of treating or preventing disorder, classified in class 514, subclass various, depending on species election.

At the outset, Applicants respectfully traverse the restriction requirement. MPEP § 803 states that the two criteria for a proper requirement for restriction are (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is required. Here, the Examiner has not shown that there would be a serious burden on the Examiner if restriction were not required. Rather, the Examiner merely states at page 2 of the Office Action, ". . .groups I-III compounds differ in elements, bonding arrangement and chemical structure to such an extend [*sic: extent*] that a reference anticipating one group would not render another group obvious." But, the Examiner has not indicated with specificity how a search for the compounds defined by the claims as originally filed would present a serious burden on the Examiner. In that regard, the Examiner has not indicated with specificity how a search for the

compounds defined by each of Groups I, II, and III would be less burdensome given the fact that the compounds in Groups I, II, and III all share the same molecular scaffold, i.e., an acyl substituted piperidine. In view of the Examiner's broad and general characterization of the state of the art, the restriction requirement appears improper. Applicants respectfully request removal of the restriction requirement at this time.

Nevertheless, to advance the prosecution of the present application and to be fully responsive to the present restriction requirement, Applicants elect Group I (claims 2, 7, 9, 11) with traverse for examination purposes. Generic claims 1, 4-6, 12-13 will be examined to the extent such claims are within the scope of the elected subject matter. In that regard, claim 1 is currently amended to reflect the elected subject matter. In addition, non-elected claims 3, 8, 10, 14-15 are withdrawn without prejudice to pursuing the subject matter of such claims in any continuing application, such as, e.g., a continuation application, a divisional application, etc.

In addition, the Examiner states at page 2 of the Office Action that if Group I is elected, a further election of a single disclosed species is also required. In response, Applicants hereby elect the following species:



Support for the above-identified species can be found throughout the specification, e.g., in originally filed claim 11.

Pursuant to MPEP § 821.04, if the compound and composition claims of elected Group I are subsequently found allowable, Applicants respectfully request that the method claims of Group IV (claims 14-15), which depend from or otherwise include all the features of the allowable compound and composition claims, be rejoined.

In addition, the Examiner cites CA 138:153539 and RN496058-17-4 at page 3 of the Office Action and asserts that compounds when W is phenyl have been known to be useful as NMDA receptor antagonists. In addition, the Examiner appears to assert that such compounds could potentially be rejected under 35 U.S.C. § 102(f) or 35 U.S.C. § 102(g) over CA 138:153539. Regarding § 102(f), without commenting substantively on the merits, Applicants note that the Examiner has not shown with support that the presently claimed subject matter was derived from CA 138:153539, which is was not. Regarding § 102(g), without commenting substantively on the merits, Applicants note that the Examiner has not shown with support that the compounds of CA 138:153539 were invented in the United States before the presently disclosed compounds were invented.

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Applicants believe that no fee is due with the filing of this paper. However, to the extent a fee is due, the Commissioner is hereby authorized by this paper to charge any required fees or credit any overpayment to Deposit Account 16-1445.

Respectfully submitted,

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